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10/719,685	11/21/2003	William R. Murray JR.	20006-7005	1898

  

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EXAMINER	
NGUYEN, DUSTIN	

  

ART UNIT	PAPER NUMBER
2154	

  

NOTIFICATION DATE	DELIVERY MODE
02/07/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/719,685

Applicant(s)

MURRAY ET AL.

Examiner

Dustin Nguyen

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-16 and 24-29 are presented for examination.

### ***Drawings***

2. The drawings are objected to because no label for Figure 2 as disclosed in the specification, paragraphs 0021-0025. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claim 27, the specification contains intrinsic evidence that "computer readable medium" includes electromagnetic, infrared and propagated. As such, they are directed to non-statutory subject matter [ see Interim Guideline for Patent Subject Matter Eligibility, MPEP, section 2106 ]. Although, Applicants point out in the Remarks that paragraph 102 of the specification states the "computer readable medium" may be "apparatus, system, device or computer memory", the term "computer readable medium" still includes transmission medium [ i.e. infrared, propagation medium ], as such it is being considered as non-statutory subject matter. Examiner suggests Applicants to amend the claim to include storage medium [ i.e. computer readable storage medium ].

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 8-10, and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Cocotis et al. [ US Patent Application No 2003/0078965 ].

6. As per claim 1, Cocotis discloses the invention as claimed including a system for remote printing of remote network resources [ i.e. system enables wireless or wired users to retrieve source data from remote resources, and request that the source data be output on selected output devices which is more often on a separate network ] [ Abstract, paragraphs 0005 and 0009 ], comprising:

a local network device to present one or more of the remote network resources responsive to a network query [ i.e. users are enabled to have a document (i.e. the remote source) stored on a remote store 74 printed at a targeted destination printer ] [ Figures 13, 41, 42; and paragraphs 0080, 0202, 0351-0353 ], each of the plurality of remote network resource capable of being printed in a tangible form [ i.e. send to target printer to produce an output document ] [ paragraphs 0324 and 0372 ] and having an identifier [ i.e. a reference identifying the network storage location of the input file ] [ paragraphs 0080 and 0244 ]; and

one or more actuatable controls associated with each of the one or more remote network resources [ i.e. the user selects to add a printer via the returned selection list ] [ Figure 45; and paragraphs 0357 and 0358 ], the one or more actuatable controls configured to initiate remote printing at a remote device responsive to communication of said identifier [ i.e. once the print job has been queued, it is processed to cause the document to be printed on the selected printer ] [ Figure 48; and paragraphs 0202 and 0358 ].

7. As per claim 2, Cocotis discloses wherein said remote device includes an image production system [ i.e. render output image data ] [ Figure 53; Abstract; and paragraph 0005 ].
8. As per claim 3, Cocotis discloses wherein said image production system includes a printer [ Abstract; paragraphs 0003 and 0004 ].
9. As per claim 4, Cocotis discloses wherein said initiation signal includes a metadata parameter of said associated remote network resource [ paragraphs 0226 and 0210 ].
10. As per claim 6, Cocotis discloses wherein said metadata parameter is identified when said associated remote network resource is indexed for said network search subsystem [ paragraphs 0154, 0280, 0344 and 0345 ].
11. As per claim 8, Cocotis discloses wherein said metadata parameter is identified by a process coupled to a compilation presentation system [ paragraphs 0004 and 0246 ].
12. As per claim 9, Cocotis discloses wherein said associated remote network resource is a document in portable document format (PDF) and said process includes a PDF access process [ paragraphs 0305 and 0323 ].
13. As per claim 10, Cocotis discloses a configurator process for configuring one or more

processing options for said processing of said remote network resource [ paragraphs 0323 and 0358 ].

14. As per claim 24, it is rejected for similar reasons as stated above in claim 1.

15. As per claim 25, it is rejected for similar reasons as stated above in claim 4.

16. As per claim 26, it is rejected for similar reasons as stated above in claim 9. Furthermore, Cocotis discloses one or more metadata parameters includes a page count [ paragraph 0346 ].

17. As per claim 27, it is rejected for similar reasons as stated above in claim 1.

18. As per claims 28 and 29, they are rejected for similar reasons as stated above in claims 4 and 26.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 5, 7, 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cocotis et al. [ US Patent Application No 2003/0078965 ], in view of Blumberg et al. [ US Patent Application No 2003/0140315 ].

21. As per claim 5, Cocotis does not specifically disclose wherein said metadata parameter includes a page length of said associated remote network resource. Blumberg discloses wherein said metadata parameter includes a page length of said associated remote network resource [ i.e. selecting type of paper ] [ paragraphs 0028 and 0068 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Cocotis and Blumberg because the teaching of selecting paper type of Blumberg would allow user to try out multiple types, personalizing them and altering them on-line without the need for the printing company to run off physical samples in multiple styles [ Blumberg, paragraph 0104 ].

22. As per claim 7, it is rejected for similar reasons as stated above in claim 5.

23. As per claim 11, Cocotis does not specifically disclose wherein said configurator process estimates a processing cost for said printing of said remote network resource using said one or more processing options. Blumberg discloses wherein said configurator process estimates a processing cost for said printing of said remote network resource using said one or more processing options [ i.e. cost determination ] [ paragraphs 0048, 0073 and 0074 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Cocotis and Blumberg because the teaching of cost determination of Blumberg



would allow to add convenience services for user to view finished document before making the purchase.

24. As per claim 12, it is rejected for similar reasons as stated above in claim 11.

25. As per claim 13, Cocotis discloses wherein said one or more metadata parameters includes a resource-size parameter [ Table 17; and paragraphs 0363 ].

26. As per claim 14, it is rejected for similar reasons as stated above in claim 5. Furthermore, Cocotis discloses wherein said resource is a document [ Abstract ].

27. As per claim 15, Blumberg discloses wherein said processing cost is included in said compilation [ paragraphs 0028 and 0068 ].

28. As per claim 16, Blumberg discloses wherein each said remote network resource of said set includes its processing cost proximate to its actuable control [ i.e. determine pricing ] [ paragraphs 0124-0130 ].

29. Applicant's arguments filed 11/26/2007 have been fully considered but they are not persuasive.

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Dustin Nguyen

Examiner

Art Unit 2154

A handwritten signature in black ink, appearing to read 'Dustin Nguyen', is written over the printed name and title.